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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,248	06/12/2001	Hao Fan	21829/81 (EBC-006)	4829

7590 11/09/2004

Michael L. Goldman
NIXON PEABODY LLP
Clinton Square
P.O. Box 31051
Rochester, NY 14603

EXAMINER

DESAI, ANAND U

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 11/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/879,248

Applicant(s)

FAN ET AL.

Examiner

Anand U Desai, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 95-130 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1, and 95-130 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 95-99, drawn to a protein which elicits a hypersensitive response in plants, said protein comprising three or more hypersensitive response eliciting domains, wherein each domain is comprised of an acidic portion linked to an alpha-helix, said acidic portion having at least 10 amino acids and a pI below 5, wherein at least one of the hypersensitive response eliciting domains is from *Erwinia amylovora*, and at least one of the hypersensitive response eliciting domains comprises amino acids 45 to 68 or 145 to 170 of SEQ ID NO: 3, classified in class 800, subclass 288, and 279.
 - II. Claims 100-102, drawn to a protein which elicits a hypersensitive response in plants, said protein comprising three or more hypersensitive response eliciting domains, wherein each domain is comprised of an acidic portion linked to an alpha-helix, said acidic portion having at least 10 amino acids and a pI below 5, wherein at least one of the hypersensitive response eliciting domains is from *Erwinia amylovora*, and at least one of the hypersensitive response eliciting domains comprises amino acids 31 to 57 or 116 to 140 of SEQ ID NO: 6, classified in class 800, subclass 288, and 279.
 - III. Claims 103-106, drawn to a protein which elicits a hypersensitive response in plants, said protein comprising three or more hypersensitive response eliciting

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domains, wherein each domain is comprised of an acidic portion linked to an alpha-helix, said acidic portion having at least 10 amino acids and a pI below 5, wherein at least one of the hypersensitive response eliciting domains is from *Erwinia chrysanthemi*, and at least one of the hypersensitive response eliciting domains comprises amino acids 85 to 116 or 256 to 292 of SEQ ID NO: 1, classified in class 800, subclass 288, and 279.

- IV. Claims 107-108, drawn to a protein which elicits a hypersensitive response in plants, said protein comprising three or more hypersensitive response eliciting domains, wherein each domain is comprised of an acidic portion linked to an alpha-helix, said acidic portion having at least 10 amino acids and a pI below 5, wherein at least one of the hypersensitive response eliciting domains is from *Pseudomonas syringae*, and at least one of the hypersensitive response eliciting domains comprises amino acids 58 to 92 of SEQ ID NO: 14, classified in class 800, subclass 288, and 279.
- V. Claims 109-112, drawn to a protein which elicits a hypersensitive response in plants, said protein comprising three or more hypersensitive response eliciting domains, wherein each domain is comprised of an acidic portion linked to an alpha-helix, said acidic portion having at least 10 amino acids and a pI below 5, wherein at least one of the hypersensitive response eliciting domains is from *Pseudomonas solanacearum*, and at least one of the hypersensitive response eliciting domains comprises amino acids 95 to 123 or 229 to 258 of SEQ ID NO: 15, classified in class 800, subclass 288, and 279.

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- VI. Claims 114-117, drawn to a protein which elicits a hypersensitive response in plants, said protein comprising two or more hypersensitive response eliciting domains, wherein each domain is comprised of an acidic portion linked to an alpha-helix, said acidic portion having at least 10 amino acids and a pI below 5, wherein at least one of the hypersensitive response eliciting domains is from *Erwinia amylovora*, and at least one of the hypersensitive response eliciting domains comprises amino acids 45 to 68 or 145 to 170 of SEQ ID NO: 3, classified in class 800, subclass 288, and 279.
- VII. Claims 118-120, drawn to a protein which elicits a hypersensitive response in plants, said protein comprising two or more hypersensitive response eliciting domains, wherein each domain is comprised of an acidic portion linked to an alpha-helix, said acidic portion having at least 10 amino acids and a pI below 5, wherein at least one of the hypersensitive response eliciting domains is from *Erwinia amylovora*, and at least one of the hypersensitive response eliciting domains comprises amino acids 31 to 57 or 116 to 140 of SEQ ID NO: 6, classified in class 800, subclass 288, and 279.
- VIII. Claims 121-124, drawn to a protein which elicits a hypersensitive response in plants, said protein comprising two or more hypersensitive response eliciting domains, wherein each domain is comprised of an acidic portion linked to an alpha-helix, said acidic portion having at least 10 amino acids and a pI below 5, wherein at least one of the hypersensitive response eliciting domains is from *Erwinia chrysanthemi*, and at least one of the hypersensitive response eliciting

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domains comprises amino acids 85 to 116 or 256 to 292 of SEQ ID NO: 1, classified in class 800, subclass 288, and 279.

- IX. Claims 125-126, drawn to a protein which elicits a hypersensitive response in plants, said protein comprising two or more hypersensitive response eliciting domains, wherein each domain is comprised of an acidic portion linked to an alpha-helix, said acidic portion having at least 10 amino acids and a pI below 5, wherein at least one of the hypersensitive response eliciting domains is from *Pseudomonas syringae*, and at least one of the hypersensitive response eliciting domains comprises amino acids 58 to 92 of SEQ ID NO: 14, classified in class 800, subclass 288, and 279.
- X. Claims 127-130, drawn to a protein which elicits a hypersensitive response in plants, said protein comprising two or more hypersensitive response eliciting domains, wherein each domain is comprised of an acidic portion linked to an alpha-helix, said acidic portion having at least 10 amino acids and a pI below 5, wherein at least one of the hypersensitive response eliciting domains is from *Pseudomonas solanacearum*, and at least one of the hypersensitive response eliciting domains comprises amino acids 95 to 123 or 229 to 258 of SEQ ID NO: 15, classified in class 800, subclass 288, and 279.
2. Claim 1 link(s) inventions I, II, III, IV, and V. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claim 1. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the

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allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

3. Claim 113 link(s) inventions VI, VII, VIII, IX, and X. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claim 113. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

The inventions are distinct, each from the other because of the following reasons:

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4. Inventions I-X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions comprise a different number of structural amino acid domains, two or three hypersensitive response domains, along with different amino acid sequences, and thus have different structure and function.

5. Because these inventions are distinct for the reasons given above and because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

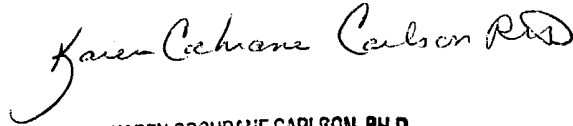
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anand U Desai, Ph.D. whose telephone number is (571) 272-0947. The examiner can normally be reached on Monday - Friday 9:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon P. Weber can be reached on (517) 272-0925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

November 3, 2004

A handwritten signature in black ink, appearing to be "A. D. S.", written in a cursive style.A handwritten signature in black ink, reading "Karen Cochrane Carlson PhD", written in a cursive style.

KAREN COCHRANE CARLSON, PH.D
PRIMARY EXAMINER